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| 10/796,814      | 03/09/2004  | M. Michael Pitts JR. | 111732.00012        | 2055             |

34282 7590 05/15/2006

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| EXAMINER |
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LEADER, WILLIAM T

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| ART UNIT | PAPER NUMBER |
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1742

DATE MAILED: 05/15/2006

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/796,814  
Filing Date: March 09, 2004  
Appellant(s): PITTS ET AL.

**MAILED**

**MAY 15 2006**

**GROUP 17C**

Gavin J. Milczarek-Desai  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed April 20, 2006 appealing from the Office action mailed November 16, 2005.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

|           |       |        |
|-----------|-------|--------|
| 5,591,317 | Pitts | 1-1997 |
|-----------|-------|--------|

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Pitts, Jr., patent number 5,591,317.

The method taught by Pitts in the '317 patent anticipates the method of instant claims 1-3. See column 7, lines 11-43 and figures 5-7. The '317 patent teaches the same apparatus that is used in the instant method, and it teaches using the apparatus with the same conditions and parameters. Claim 1 requires reducing the formation of biofilm on a wall, a result that would necessarily occur when carrying out the method of reducing scale or sludge in a water system.

**(10) Response to Argument**

Appellant argues that the instant application must be given the filing date of the patent '317 patent. The complete priority chain is as follows: instant application SN 10/796,814 is a continuation of SN 10/047,493 (abandoned), which is a continuation-in-part of SN 09/416,255 (abandoned), which is a continuation-in-part of SN 09/167,115 (abandoned), which is a continuation-in-part or SN 08/779,819 (issued as patent number 5,817,224); which is

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continuation-in-part of SN 08/197,154 (issued as patent number 5,591,317). As stated in MPEP 2133.01, when an applicant files a continuation-in-part whose claims are not supported by the parent application, the effective filing date is the filing date of the child CIP, and any prior art disclosing the invention having a reference date more than 1 year prior to the filing date of the child will bar the issuance of a patent under 3 U.S.C. 102(b). The claims of the instant application are not considered to be supported by the disclosure of 08/197,154 which issued as patent 5,591,317. While the '154 patent discloses the same electrostatic-field generator used in the instant method, the '154 application does not disclose a method for reducing the formation of biofilm deposits on a wall in a water system. Other than immediate parent application SN 10/047,493 filed on January 14, 2002, none of the other applications in the priority chain disclose a method for reducing the formation of biofilm deposits on a wall in a water system. Thus, the effective filing date of the instant application is January 14, 2002. The Pitts, Jr. '317 patent issued on January 7, 1997, more than one year prior to the effective filing date of the instant application and is considered to be a reference against the instant claims.

Appellant has argued that even if claims 1-3 were not supported by the disclosure of the '317 patent, this patent still cannot anticipate the present application because a lack of supporting disclosure means that one or more elements of claims 1-3 must be missing from the '317 patent. As noted above, appellant's claims are directed to a method for reducing the formation of biofilm deposits. The claims do not require that an initial biofilm be present. They require only that the formation of biofilm deposits be reduced. The use of the electrostatic-field generator disclosed and claimed in the '317 patent is considered to necessarily result in reducing the formation of biofilm deposits.

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**(11) Related Proceeding(s) Appendix**

There is no evidence appendix.

**(12) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

  
William Leader

Conferees:

  
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